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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,104	12/31/2001	Bertus Karel Edens	029150-116	6139

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EXAMINER

SHAPIRO, JEFFERY A

ART UNIT PAPER NUMBER

3653

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/032,104	EDENS, BERTUS KAREL	
	Examiner	Art Unit	
	Jeffrey A. Shapiro	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 19 and 20 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It appears that "data regarding said operating condition is determined prior to the preparation of the mail piece..." has already been stated in Independent Claims 9 and 11.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, Jr. et al (US 6,119,051) in view of Shimada et al (US 2001/0031150 A1). Anderson discloses Applicant's claimed computer program and apparatus as follows.

As described in Claims 9, 11 and 21;

- a. at least one finishing assembly (60) for producing mail pieces;
- b. a sensor for registering a current physical property of a current condition of said at least one finishing assembly; (See col. 11, table 5, lines 45-65, which indicate that, for example, weight of the mailpiece is

sensed. Note that a sensor, such as a scale, would be obvious to use, otherwise, the system would not work to detect weight data, for example. Note also that the system of Anderson detects whether or not a particular mailpiece is a duplicate or not. This again, implies the use of sensors, such as imaging devices, to compare with prior recorded mailpieces.)

c. representation means (note that the computerized system of Anderson provides a computer with data in the form of a report, such as Table 5, found on col. 11);

d. a control structure (see figure 1) communicatively linked with said finishing assembly, said sensor and said representation means, said control structure being provided with code for;

da. determining data regarding a required operating condition applying to the production of at least one mail piece (see col. 7, lines 5-22);

db. determining at least one physical property to be realized manually of said required operating condition *prior to the production of mailpieces* (see col. 9, lines 30-67 and col. 10, lines 1-29, noting that the material is physically loaded on the processing machine);

dc. registering at least one current physical property of a current condition of said mail production apparatus (see table 4, noting that the current location (tray id) and the target destination is recorded/registered in the computer) ;

dd. determining a difference between said at least one current physical property and said at least one property to be realized manually of said required operating condition (note again, the weight recorded in table 5 as well as whether or not the mailpiece is a duplicate or not—see col. 6, lines 1-19);

de. causing an indication associated with said difference to be represented in humanly perceptible form (again, note that all of the tables and data appear to be presented in report form, readable by humans);

df. causing said at least one mail piece to be composed by said finishing assembly in said operating condition (see again, col. 9, lines 60-67 and col. 10, lines 1-29);

dg. Subsequently causing said mail piece or said series of mail pieces to be prepared by said mail production apparatus in said operating condition; (see again, col. 9, lines 60-67 and col. 10, lines 1-29)

As described in Claim 10;

e. an information carrier provided with machine-readable data constituting a computer program (note that it would be obvious to provide the computer program on a number of obvious formats, such as a hard drive, compact disc, or floppy disc);

As described in Claim 12;

f. a memory structure communicatively linked with said control structure for storing data which represents a directly preceding operating condition (note col. 3, lines 64 and 65, which state that the computer is an intel Pentium class computer, which is understood to have a memory, other wise, the record id, for example, as mentioned in col. 4, lines 54-56, would not able to be stored—see also col. 4, lines 1-6);

g. wherein said control structure is further arranged for determining at least one property of said current condition by determining at least one property of said directly preceding operating condition (again, see tables 4 and 5);

As described in Claim 13;

h. said control structure is further arranged for determining operations to be performed manually for bringing said finishing assembly from said current condition into said required operating condition and representing said operations to be performed with said representation means in humanly perceptible form (see col. 4, lines 6-30);

As described in Claim 14;

i. said control structure is further arranged for registering the current condition again after the performance of one of said operations to be performed and representing in humanly perceptible form at least one residual operation of said operations to be performed (see tables 4 and 5);

As described in Claim 15;

j. an item sensor communicatively linked with said control structure, for registering loaded physical postal items (note also the use of an imager in col. 9, lines 30-59);

k. wherein said control structure is further arranged for determining physical postal item types associated with said required operating condition, registering loaded physical postal items, determining at least one type of said loaded physical postal items, and representing at least one type of physical postal items to be loaded (see col. 7, lines 6-22);

As described in Claim 16;

l. representing with said representation means, in addition to the or each type of physical postal items to be loaded, a loading position for physical postal items of that type to be loaded (see tables 4 and 5);

As described in Claim 17;

m. representing a property of physical postal items of said type to be loaded (again, note that "weight" is represented in tables 4 and 5);

As described in Claim 18;

n. said item sensor is arranged for registering an item property of said loaded physical postal items (note that the imager registers the entire mailpiece, including length, width, and surface features);

As described in Claims 19 and 20;

- o. *data regarding said required operating condition is determined prior to the preparation of the mail piece or series of mail pieces; (note that the data used by Anderson's system is determined prior to the setup of the job and that this data is acquired in a fashion such as reading the parameters from the control insert.)*

Anderson does not expressly disclose, but Shimada discloses use of a semi-automated control scheme having user-defined macros, such as user-defined manual change key (6506) to, in this case, change the sheet on manual feed tray (3211). See also Shimada, figure 52.

Both Anderson and Shimada are considered to be analogous art because they both concern sheet feeding and document association.

At the time of the invention it would have been obvious to one ordinarily skilled in the art to have performed any or all of the steps in one of Anderson's control inserts in a manual or semi-automated fashion, prompting the operator to change a particular parameter manually, through a user-defined change key or macro, as taught by Shimada.

The suggestion/motivation would have been to allow for operator intervention and process flexibility.

Note also that it is obvious for an automated process to be performed manually. As an extreme, but illustrative example, note that instead of transporting the sheets

automatically by conveyor, the operator could take the sheets and take them from one station to another after each process of the job is performed.

In the alternative, note also that Anderson meets the limitations of the claims except that it employs a fixed control system rather than a control system having an adjustable macro to allow for adjustment of size of paper, paper stops, etc. However, it has been held to be within the general skill of a worker in the art to make an adjustment from previously fixed elements as a matter of obvious engineering choice. Therefore it would have been obvious to one of ordinary skill to make the automated set up routine of the reference adjustable to facilitate semi-automated flexibility represented by prompts with macros to allow an operator to adjust various parameters of Anderson's system manually as suggested by (Shimada) at p.25, paragraph 391. *In re Stevens*, 212 F.2d 197, 101 USPQ 284(CCPA 1954).

Response to Arguments

4. Applicant's arguments filed 3/14/05 have been fully considered but they are not persuasive. As representative of Applicant's claims, consider independent claim 9. It requires determining data regarding said operating condition/s, determining at least one physical property to be realized manually of said required operating condition, registering at least one current physical property, determining a difference between said at least one current physical property and said at least one property to be realized

manually of said required operating condition, causing an indication associated with said difference to be represented in humanly perceptible form, and causing said mail pieces to be prepared in said operating condition.

Anderson's system reads on the independent claims. What is termed by Applicant as a property is really an operating parameter. These parameters are described by both Applicant's specification at p.7, lines 28-30 and p.8, lines 1-3 and Anderson at table 5 as including the dimensions of the insert paper, the envelopes, the type of paper, whether to have a z-fold, use stapling, etc.

Regarding realization of a parameter by manual operation of the system, note col. 11, lines 5 and 6 indicate a "pull key", which is a customer defined key to look up a certain mailpiece, and a "user field" which is a customer defined key for customer use. Such keys are construed as user-defined macros, which highly suggests user customizable parameters. Such parameters which are designated user-defined, are changeable from a prior state to a desired state. Otherwise, the system would not work. In other words, the current state of the user-defined parameter can be brought up on screen, its state then changed, therefore changing the program that controls the processing of the job. Therefore, for example, one ordinarily skilled in the art would realize that one could, for example, add an extra insert in addition to the normal single insert, or to add a z-fold to a single insert, which normally does not have one. The change to a user-defined macro is suggested as being placed in a human perceptible form by indication on a computer screen or in paper printout format. See figure 1, which

illustrates a report printer and note that indication on either a display or on paper are considered to be functional equivalents of each other.

Note further, col. 9, lines 60-67 and col. 10, lines 14-29, which indicates that “if the ‘name’ of the database driven insertion data is not specified... the users must select which set of database driven insertion data to use from the database.” This can be construed to meet the definition of manual realization of at least one physical property and human perceptible indication of a difference in that the “name” of the insertion data is not specified.

Again, as Applicant stated on p. 11, lines 7-9, “the claimed invention provides a computer program which allows an operator to see what needs to be done in order to bring the apparatus into a required condition in order to produce a mail piece. This is just what is described by Anderson—performing a computer-aided insertion job which is able to be operator modified. Therefore, Anderson does not simply disclose a database generation program, but also an entire system for performing a particular insertion job on a mailpiece finishing system. This is also why job tracking performed by Anderson’s system is important to the operator—to allow for operator intervention regarding particular situations.

Applicant is correct that simply “generating database instructions is not the same as bringing an apparatus into a required operating condition prior to preparation of the mailpiece(s),” except where the database instructions are later used to control the setup and operation of the insertion system. This is what is described by Anderson.

Additionally, even if it can be argued that Anderson only teaches tracking job data, one ordinarily skilled in the art would recognize that the data is obtained from information channels such as sensors, and that it would be obvious to use the information in another format, such as sampling it in a real-time manner. Note also that regardless of whether or not the parameter fits the intended use language "to be realized manually," it can be argued that the system of Anderson and of Applicant's claimed apparatus works the same regardless of how the parameter is realized. Again, note that it would have been obvious to automate a manual process or to make manual automated processes.

Shimada has been added as a further teaching of having a user defined macro in a document assorter control system so that an operator may change a particular system parameter, such as size of sheets, etc. Note also that since there is only two alternatives to perform such functions (such as changing stops or changing size of paper, for example) the alternatives being performing the task automatically or manually. One ordinarily skilled in the art would have found it obvious to provide the option for manual input by the operator in Anderson's system. This would provide flexibility to the system in handling non-standard jobs.

Therefore, Claims 9-21, reasonably and broadly construed, are rejected.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Federico et al '156 is cited as an example of a control system for

a document assorter having user defined macros. Hart, Jr. et al '835 is cited as an example of a mailpiece generator that uses control documents to set up jobs.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (571)272-6944. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro
Examiner
Art Unit 3653

May 31, 2005



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